

REMARKS

At the time of the Office Action dated July 12, 2006, claims 1-25 were pending in this application. Of those, claims 1-20 and 22-25 were rejected. Applicants acknowledge, with appreciation, the Examiner's indication that claims 3, 14, and 21 contain allowable subject matter. Claims 16 and 17 have been cancelled.

CLAIMS 1-7 AND 11-17 ARE REJECTED UNDER 35 U.S.C. § 101

With regard to claims 1-7, the Examiner asserted the following on page 2 of the Office Action:

those claims disclose the method or program, which is not embodied in the computer readable storage medium as clearly stated in claim 8.

There is **no requirement** that a method, which can be performed by a computer, must be claimed as part of a computer readable medium. The U.S. Patent Office has already issued thousands, if not tens of thousands of patents, which include similar types of claims since the Federal Circuit's decision of State Street Bank & Trust Co. V. Signature Financial Group, Inc.¹ Although issued prior the State Street Bank decision, the Examiner is referred to U.S. Patent No. 5,333,184 (hereinafter the '184 patent). Claim 1 of the '184 patent is reproduced below:

1. A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of:

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and

¹ 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1999).

including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

Upon reviewing this claim, it is readily apparent to a layman in the art that all of the method steps recited in this claim could be performed by a computer. Thus, if the Examiner's analysis on page 2 of the present Office Action was followed at the time the application, which matured into the '184 patent, was examined, then this claim would have been rejected under 35 U.S.C. § 101.

Applicants have referred to the '184 patent because this patent was the subject of the decision by the Federal Circuit in AT&T Corp. v. Excel Communications, Inc.² The conclusion of the Federal Circuit with regard to the '184 patent is "we find that the claimed subject matter is properly within the statutory scope of 101." Thus, the Examiner's implied assertion that claims directed to a method that are capable of being implemented in software alone is per se not directed to statutory subject matter directly contradicts the decision by the Federal Circuit that the claimed subject matter recited in the '184 patent is directed to statutory subject matter. Moreover, the Examiner has failed distinguish between the present claims and the claims of the '184 patent so as to support a finding that the present claims are not directed to statutory subject matter.

Applicants are unaware of any case law that has overturned AT&T Corp. In fact, the Examiner is also directed to the first page of the latest version of the "Interim Guidelines for

² 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

Examination of Patent Applications for Patent Subject Matter Eligibility"³ issued on November 22, 2005 (hereinafter "Interim Guidelines"). Specifically, Applicants note that the Federal Circuit decision of AT&T Corp. is mentioned side-by-side with the State Street Bank decision. Therefore, it is readily apparent that the Federal Circuit decision of AT&T Corp. is still good law, which must be followed by the Examiner.

Similarly, with regard to claims 11-15, the Examiner stated the following on page 2 of the Office Action:

those claims disclose the system performing software instructions, however according to claims 16 and 17, the application uses following terms "a computer program product" and "an article" respectively. Those terms on its own do not constitute statutory subject matter since those phrases could be just another way of reciting software.

The Examiner is respectfully requested to point out exactly where within the Interim Guidelines support for the Examiner's assertion can be found.

Furthermore, with regard to claims 11-15, Applicants note that these claims are directed to a machine, and on this basis, without need for further argument, claims 11-15 are directed to statutory subject matter. In the decision of In re Warmerdam,⁴ the Court concluded that the method claims recited in claims 1-4 "[involve] no more than the manipulation of basic mathematical constructs, the paradigmatic 'abstract idea.'" The Court then sustained the rejection of claims 1-4 under 35 U.S.C. § 101.

However, the Court noted that claim 5 of the same application recited "[a] machine having a memory which contains data representing a bubble hierarchy generated by the method

³ Official Gazette Notices, November 22, 2005.
4 3 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994).

of any of Claims 1 through 4." With regard to this claim, the Court stated that "[c]laim 5 is for a machine, and is clearly patentable subject matter" despite the prior finding that the method being performed by the machine was non-statutory subject matter. Therefore, since claims 11-15 are directed to a machine, then claims 11-15 are directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

Therefore, for the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-7 and 11-15 under 35 U.S.C. § 101.

**CLAIMS 1, 4, 9-11, 15, 19, AND 22 ARE REJECTED UNDER 35 U.S.C. § 102 FOR
ANTICIPATION BASED UPON BHAT, U.S. PATENT PUBLICATION NO. 2003/0055808**

On pages 3-5 of the Office Action, the Examiner asserted that Bhat discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.⁵ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.⁶ This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in

⁵ *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

⁶ *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, *supra*.

Bhat being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).⁷

Had the Examiner more clearly identified those elements being relied upon in Bhat vis-à-vis the claimed limitations recited in the claims, it would have been readily apparent that Bhat fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102.

With regard to the step of "converting an event log file of a first log type and structure associated with a sending node into a predefined format," as recited in claim 1, the Examiner referred to paragraphs [0055]-[0057] of Bhat. However, upon reviewing these cited paragraphs, Applicants note that these paragraphs refers to the use of property files by CIMON 142. Regarding the claimed step of "transmitting the converted event log file over the network to the unified log server," the Examiner referred to steps 360 and 370 found in Figure 3. Upon reviewing Bhat, Applicants note that paragraph [0072] describes both step 360 and step 370. These steps refers to actions of the logging service 141, which reads the property file from the CIMOM 142 (i.e., step 360) and coverts information within the property file into an implementation object (i.e., step 370).

Referring to Figure 1 of Bhat, it is readily apparent that both the logging service 141 and the CIMON 142 are found within the server 140. However, on page 3 of the Office Action, the

⁷ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Examiner identified the server 140 described in Figure 1 of Bhat as identically disclosing the claimed "unified log server." This Examiner also asserted that the server 140 identically discloses the claimed "receiving the converted event log file by the unified log server," as recited in claim 1. Applicants respectfully submit that the server 140 (i.e., the asserted unified log server) cannot receive the converted event log file, since both the CIMOM 142 and the logging service 141, which were asserted by the Examiner as creating and transmitting the converted event log file, are already within the server 140. On this basis alone, Applicants solicit withdrawal of the imposed rejection of claims 1, 4, 9-11, 15, 19, and 22 under 35 U.S.C. § 102 for anticipation based upon Bhat.

Notwithstanding this fatal flaw in the rejection of the claims based upon Bhat, Applicants note that further fatal errors exist within the statement of the rejection. For example, the Examiner referred to paragraphs [0055]-[0057] of Bhat to teach the claimed "converting an event log file of a first log type and structure associated with a sending node into a predefined format." Upon reviewing these passages, Applicants note the teaching of a "property file." However, the Examiner has neither factually established nor set forth a reasoned explanation as to why one having ordinary skill in the art would construe the term property file as teaching the claimed event log file.

With regard to the claimed "determining the log type of the converted log file and routing the converted log file to a log handler compatible with the log type and the predefined format," the Examiner cited lines 12-15 of paragraph [0055]. This cited passage merely refers to a system administrator being able to edit the property file to define a property specific to file storage type

devices. Applicants, however, cannot even imagine how one having ordinary skill in the art could conceivably recognize this passage as identically disclosing the above-identified claim limitation.

Therefore, for the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1, 4, 9-11, 15, 19, and 22 under 35 U.S.C. § 102 for anticipation based upon Bhat.

CLAIMS 2, 12, AND 20 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON BHAT IN VIEW OF SULLIVAN ET AL., U.S. PATENT PUBLICATION NO. 2004/0172284 (HEREINAFTER SULLIVAN)

On page 6 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Bhat in view of Sullivan to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 2, 12, and 20 depend ultimately from independent claims 1, 11, and 19, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1, 11, and 19 under 35 U.S.C. § 102 for anticipation based upon Bhat. The secondary reference to Sullivan does not cure the argued deficiencies of Bhat. Accordingly, even if one having ordinary skill in the art were motivated to modify Bhat in view of Covert, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 2, 12, and 20 under 35 U.S.C. § 103 for

obviousness based upon Bhat in view of Sullivan is not viable and, hence, solicit withdrawal thereof.

CLAIMS 5 AND 23 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON BHAT IN VIEW OF COVERT ET AL., U.S. PATENT NO. 5,982,995 (HEREINAFTER COVERT)

On pages 6 and 7 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Bhat in view of Covert to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 5 and 23 depend ultimately from independent claims 1 and 19, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1, and 19 under 35 U.S.C. § 102 for anticipation based upon Bhat. The secondary reference to Covert does not cure the argued deficiencies of Bhat. Accordingly, even if one having ordinary skill in the art were motivated to modify Bhat in view of Covert, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 5 and 23 under 35 U.S.C. § 103 for obviousness based upon Bhat in view of Covert is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 6-8, 16-17, AND 24-25 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON BHAT IN VIEW OF COVERT AND FALLS ET AL., U.S. PATENT NO. 6,247,149
(HEREINAFTER FALLS)**

On pages 7 and 6 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Bhat in view of Covert and Falls to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 6-8 and 24-25 depend ultimately from independent claims 1 and 19, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1, and 19 under 35 U.S.C. § 102 for anticipation based upon Bhat. The secondary references to Covert and Falls do not cure the argued deficiencies of Bhat. Accordingly, even if one having ordinary skill in the art were motivated to modify Bhat in view of Covert and Falls, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claims 6-8 and 24-25 under 35 U.S.C. § 103 for obviousness based upon Bhat in view of Covert and Falls is not viable and, hence, solicit withdrawal thereof.

**CLAIM 13 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON BHAT IN
VIEW OF FALLS**

On page 8 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Bhat in view of Falls to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 13 depends ultimately from independent claim 11, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 11 under 35 U.S.C. § 102 for anticipation based upon Bhat. The secondary reference to Falls does not cure the argued deficiencies of Bhat. Accordingly, even if one having ordinary skill in the art were motivated to modify Bhat in view of Falls, the proposed combination of references would not yield the claimed invention. Applicants, therefore, respectfully submit that the imposed rejection of claim 13 under 35 U.S.C. § 103 for obviousness based upon Bhat in view of Fall is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

Application No.: 10/730,656

including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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